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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/509,556	09/29/2004	Alain Delval	930024-2013	5915
7590 Ronald R Santucci Frommer Lawrence & Haug 745 Fifth Avenue New York, NY 10151			EXAMINER WILSON, JOHN J	
			ART UNIT 3732	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		03/13/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/509,556	DELVAL ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	John J. Wilson	3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 29 September 2004.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-11 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 29 September 2004 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/29/04</u> | 5) <input type="checkbox"/> Notice of Informal Patent Application |
|  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 7, 9 and 11 are rejected under 35 U.S.C. 101 because the disclosed invention is inoperative and therefore lacks utility. The rotation of the tool as disclosed would also rotate the tool at the bend. This would cause the bent portion of the tool to crimp, fatigue and break, and/or create such forces on the pivot elements 28, 29, 32 so as to render them inoperable.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 7, 9 and 11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The rotation of the tool as disclosed would also rotate the tool at the bend. This would cause the bent portion of the tool to crimp, fatigue and break, and/or create such forces on the pivot elements 28, 29, 32 so as to render them inoperable. The disclosure does not teach materials that can be used to make the tool and/or pivot

elements that would not destruct in use. Determining these materials or determining how to rotate the tool without destroying the holder is more than routine investigation for one of ordinary skill in the art, and therefore, claims to this embodiment are not enabled.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1, "whose generatrices" is unclear. This is the plural form of generatrix, an element or line that generates a surface when moved. It is not clear what is meant by plural lines? Also, if one line is claimed, the line would not always be parallel to the axis of the cylindrical part, therefore, it is unclear what is meant by parallel to the axis.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cislak (1993398). Cislak shows a tool holder having an elongated body 13, channel 15, 16, cylindrical part of the channel 15 and widened part of the channel 16, means 22 for keeping a tool in position, and as shown, a generatrix of the widened channel 16 is

parallel to the axis of the cylindrical part 15. The intended use of this shown structure with an inferentially claimed flexible deformable tool is not given any patentable weight. The specific manner in which the shown structure may interact with the inferentially claimed tool in use is held to be an obvious matter of choice in the use of a known structure. As to claims 4-6, the type of connection used is an obvious matter of choice in well known connecting means to one of ordinary skill in the art. As to claim 8, the shown tool is inherently flexible and deformable to some degree. The shown elements that are intended to mate with the inferentially claimed tool are capable of allowing rotation.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cislak (1993398) as applied to claim 9 above, and further in view of Gibbs (6468248). Cislak shows the structure as described above, however, does not show means for rotation of the tool. Gibbs teaches means for rotating a tool, Fig. 7A. It would be obvious to one of ordinary skill in the art to modify Cislak to include rotation means as shown by Gibbs in order to cut material when desired.

### *Drawings*

The drawings submitted September 29, 2004 have been found to be acceptable by the examiner.

***Priority***

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Information Disclosure Statement***

The IDS received September 29, 2004 has been considered and an initialed copy is attached.

***Specification***

The specification should not refer to claims, see pages 3 and 4.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Dragan et al (6135771), Lopez (4624393), Friedman (3640278) and Roehr (2531893) show known connecting means. Barr, Sr. et al (3326206) and Leonard et al (4710178) shows angled tools. Butuzov et al (5891106) shows bending a tool.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Wilson whose telephone number is 571-272-4722. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cris Rodriguez, can be reached at 571-272-4964. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



*John J. Wilson*  
**John J. Wilson**  
**Primary Examiner**  
**Art Unit 3732**

jjw  
March 7, 2007